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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,269	03/12/2004	Massimo Rossi	HOFF-36494	8666
116 7590 02/10/2009 PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			EXAMINER YOON, TAE H	
			ART UNIT	PAPER NUMBER
			1796	
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			02/10/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/799,269

Applicant(s)

ROSSI ET AL.

Examiner

Tae H. Yoon

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-28 is/are rejected.
- 7) ☒ Claim(s) 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

A clarification (amendment) to line 26, page 10 of specification is needed since said page contains numerous small dots (it looks like a period in certain locations) including the one before "20" in said line. Thus, it looks like ".20 to 60% by weight". See the instant publication (US 2004/0229971 A1), PP [0082] in which "0.20 to 60% by weight" is printed.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-18 and 20-28 are rejected under 35 U.S.C. 103(a) as obvious over Fernandes (US 5,603,616) in view of Bublewitz et al (US 2005/0239958 A1) and Jacob et al (US 6,342,187).

Fernandes teaches a method for impression taking in immediate-loading at col. 9, in which silicone material containing radio-opaques and an inspection by a radiographer are also taught (lines 18-27) since any residue of the impression material would cause infection (abstract). The recited radiography machines are found in dental offices inherently.

The instant invention further recites an aseptic polysiloxane composition containing radio-opacifying filler over Fernandes. However, said two-component polysiloxane impression taking composition is well known as taught by Bublewitz et al, [0048] - [0065] and examples wherein the instant viscosity is seen. Bublewitz et al also

teach employing various reinforcing and non-reinforcing fillers including zinc oxide in [0112] – [0113] and [0116]. Said [0113] teaches the instant BET surface, and acids in said [0116] would meet the instant reticulating agent. With respect to the amount of a radiopaque material, it would have been obvious to adjust such amount in Bublewitz et al since said amount must provide a good radiography.

Sterilization of devices and materials used in dental and medical practices by various methods such as X-ray is well known practice as taught by Jacob et al, col. 2.

It would have been obvious to one skilled in the art to sterilize said polysiloxane dental impression material containing the instant amount of zinc oxide and other filler of Bublewitz et al with X-ray of Jacob et al before use in immediate loading of Fernandes since sterilization of devices and materials used in dental and medical practices by various methods such as X-ray in order to prevent any infection to patients is well known practice, and further to use art known silicone impression taking material such as that of Bublewitz et al in Fernandes would be a *prima facie* obviousness since Fernandes teaches silicone impression taking material containing radio-opaquers and since use of zinc oxide in the instant amount in Bublewitz et al also would be a *prima facie* obviousness since Bublewitz et al teach zinc oxide and since said amount must provide a good radiography absent showing otherwise.

Claims 14-28 are rejected under 35 U.S.C. 103(a) as obvious over Fernandes (US 5,603,616) in view of Bublewitz et al (US 2005/0239958 A1) and Jacob et al (US 6,342,187), and further in view of Schwabe et al (US 4,965,295).

The instant claim 19 further recites silicone oil over Bublewitz et al who teach mineral oil in example 6. Schwabe et al teach silicone oils as plasticizers at col. 3, lines 7-16, and silicone oil is one of well known mineral oils.

It would have been obvious to one skilled in the art to utilize said silicone oil of Schwabe et al in polysiloxane dental impression material containing the instant amount of zinc oxide and other filler of Bublewitz et al in combination with Fernandes and Jacob et al as the reason given above and since silicone oil is one of well known mineral oils, infection absent showing otherwise.

Claims 14-18 and 20-28 are rejected under 35 U.S.C. 103(a) as obvious over Porter et al (US 2003/0036036 A1) in view of Bublewitz et al (US 2005/0239958 A1), and Jacob et al (US 6,342,187), and in view of Fernandes (US 5,603,616).

Now, the instant invention further recites a step of inspection for any residual radiopaque (impression taking) material and radiography machines and an amount of a radiopaque material over Porter et al, Bublewitz et al and Jacob et al.

However, such inspection after impression taking is well known in the art as taught by Fernandes (col. 9, lines 25-27) since such residue would cause infection (abstract). The recited radiography machines are found in dental offices inherently.

With respect to the amount of a radiopaque material, it would have been obvious to adjust such amount in Bublewitz et al since said amount must provide a good radiography.

It would have been obvious to one skilled in the art to sterilize said polysiloxane dental impression material containing zinc oxide in the instant amount and other filler of Bublewitz et al with X-ray of Jacob et al before use in immediate loading of Porter et al since sterilization of devices and materials used in dental and medical practices by various methods such as X-ray in order to prevent any infection to patients is well known practice, and further to use any art known impression taking material such as that of Bublewitz et al in Porter et al would be a *prima facie* obviousness and since use of zinc oxide in the instant amount in Bublewitz et al also would be a *prima facie* obviousness since Bublewitz et al teach zinc oxide and since said amount must provide a good radiography, and further to inspect a patient's mouth after taking an impression of Porter et al with teaching of Fernandes since any residue of the impression taking material would cause infection absent showing otherwise.

Claims 14-28 are rejected under 35 U.S.C. 103(a) as obvious over Porter et al (US 2003/0036036 A1) in view of Bublewitz et al (US 2005/0239958 A1), and Jacob et al (US 6,342,187), and further in view of Fernandes (US 5,603,616) and further in view of Schwabe et al (US 4,965,295).

The instant claim 19 further recites silicone oil over Bublewitz et al who teach mineral oil in example 6. Schwabe et al teach silicone oils as plasticizers at col. 3, lines 7-16, and silicone oil is one of well known mineral oils.

It would have been obvious to one skilled in the art to utilize said silicone oil of Schwabe et al in polysiloxane dental impression material containing the instant amount

of zinc oxide and other filler of Bublewitz et al since silicone oil is one of well known mineral oils, and then to sterilize it with X-ray of Jacob et al before use in immediate loading of Porter et al since sterilization of devices and materials used in dental and medical practices by various methods such as X-ray in order to prevent any infection to patients is well known practice, and further to use any art known impression taking material such as that of Bublewitz et al in Porter et al would be a *prima facie* obviousness and since use of zinc oxide in Bublewitz et al also would be a *prima facie* obviousness since Bublewitz et al teach zinc oxide, and further to inspect a patient's mouth after taking an impression of Porter et al with teaching of Fernandes since any residue of the impression taking material would cause infection absent showing otherwise.

Claim 29 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

An examiner's comment in the previous office action was not a suggestion contrary to applicant's statement since such inspection step was not searched and thus it was unclear whether claims with such step would be allowed or not at the time of the last office action.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tae H Yoon/
Primary Examiner
Art Unit 1796

THY/February 6, 2009